

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES**

In re patent application of:
Badura, et al.

Atty. Docket No.: YOR920010552US1

Serial No.: 09/943,841

Group Art Unit: 3623

Filed: August 31, 2001

Examiner: Graysay, Tamara L.

For: ELECTRONIC METHOD FOR DETERMINING PROCUREMENT BUSINESS
STRATEGY

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APPELLANTS' REPLY BRIEF

Sirs:

In response to the Examiner's Answer, mailed December 26, 2007, Appellants submit the following reply.

Appellants traverse the rejections because the proposed combination of Dalheimer and Marsh fails to teach or suggest the claimed features of “evaluating a cost effectiveness of a mode of communication based on a first party’s ability to communicate” as defined in independent claims 1, 8, and 14. The Examiner argues that the “communication channels” of Dalheimer teach the “modes of communication” of the claimed invention (Examiner’s Answer, p. 6 item (d)). Moreover, the Examiner argues that the “communication channels” of Dalheimer are evaluated based on “cost” (Examiner’s Answer, pp. 15-16 item 10). However, Appellants submit that, unlike the claimed invention, Dalheimer does not teach or suggest the claimed element that such “cost” is evaluated based on a first party’s ability to communicate. Instead, Dalheimer

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merely discloses determining the cost of a communication channel irregardless of the individual party's ability to communicate.

More specifically, the only portion of Dalheimer that discusses "costs" is provided in the second paragraph on page 2. Dalheimer provides that "[s]ome aspects to consider when selecting communication channels are asynchronous vs. synchronous channels, latency, and cost" (Dalheimer, p.2, para. 2).

Nevertheless, Dalheimer does not teach or suggest the claimed element that such "cost" is evaluated based on a first party's ability to communicate. Dalheimer does not evaluate the "cost" in any way, but merely states that cost is an aspect to "consider". Dalheimer fails to disclose whether the "cost" is based on the seller's ability to communicate or the buyer's ability to communicate. Any interpretation beyond "considering cost when selecting communication channels" in light of Dalheimer would be based on hindsight. The claimed invention goes well beyond considering cost and instead evaluates cost effectiveness based on a party's ability to communicate.

Furthermore, the Examiner asserts that the "cost" is the cost to the "user/buyer" for implementation/adoption of a specific communications option (Examiner's Answer, p. 15, para. 2). However, Appellants submit that in determining the costs of the "communication channels", Dalheimer does not differentiate between the seller's ability to communicate and the buyer's ability to communicate. Instead, Dalheimer merely discloses determining the cost of a communication channel irregardless of the individual party's ability to communicate.

For example, a seller could be located in a remote area of the world, which is not easily accessible by automobiles. Thus, the seller's ability to communicate via ground

delivery is low. On the other hand, the buyer could be located in a large city, wherein the buyer often utilizes bicycle couriers to send and receive messages. Thus, the seller's ability to communicate via ground delivery is high.

The system and methods of Dalheimer, do not differentiate between the seller's ability to communicate and the buyer's ability to communicate. For instance, the table on the top of page 2 of Dalheimer merely provides that "Postal mail" has a cost of "Medium". Nevertheless, Dalheimer does not offer insight as to whether the cost of postal mail is based on the seller's ability to communicate or the buyer's ability to communicate.

Referencing page 2 of Dalheimer, the Examiner argues that the "communication channels" of teach the "modes of communication" of the claimed invention (Examiner's Answer, p. 6, item (d)). Referring to the "Video conferencing" communication channel on the table in Dalheimer (p. 2), Dalheimer does not indicate whether the cost is based on the seller's ability to communicate or the buyer's ability to communicate. For example, the seller could be a telecommunications company and the buyer could be an Arctic research team. Thus, the seller's ability to communicate via video conferencing would be significantly higher than the buyer's ability to communicate. Nevertheless, nothing within Dalheimer teaches evaluating the cost effectiveness of video conferencing based on the seller's ability to communicate. Moreover, nothing within Dalheimer teaches evaluating the cost effectiveness of video conferencing based on the buyer's ability to communicate. Instead, Dalheimer merely discloses that the cost of communicating via video conferencing is "Medium to high" (Dalheimer, p. 2).

In addition, the Examiner argues that Marsh discloses evaluating a cost effectiveness of a mode of communication based on a first party's ability to communicate (Examiner's Answer, p. 4, item (b)). In support for this contention, the Examiner cites column 8, lines 54-62, of Marsh. Appellants respectfully disagree with such a conclusion and submit that nothing within Marsh, including the portions cited by the Examiner, teaches or suggests evaluating a cost effectiveness of a mode of communication based on a first party's ability to communicate. Instead, Marsh only evaluates whether a subscriber of a wireless service is on an optimal service plan based on usage patterns.

In other words, nothing within Marsh teaches or suggests evaluating the cost effectiveness of a mode of communication (e.g., the "wireless service") of the modes of communication (e.g., internet, fax, postal delivery). Instead, Marsh only discloses determining whether the subscriber is on the optimal service plan for a single mode of communication ("wireless service").

Appellants submit that that the "service plans" of Marsh are not "modes of communication"; rather, the service plans of Marsh are different billing options for a single mode of communication ("wireless service"). For example, whether a user is paying \$30 a month for 500 wireless minutes or \$50 a month for 1000 wireless minutes, the mode of communication is still the same. To the contrary, a user can pay \$30 a month for 500 Internet minutes and \$30 a month for 500 cellular telephone minutes, wherein the Internet minutes and cellular telephone minutes are different modes of communication.

In other words, the "service plans" of Marsh do not teach the "modes of communication" of the claimed invention because a first service plan does not employ a

different mode of communication than a second service plan. Instead, given the system and method in Marsh, both the first and second service plans employ the same mode of communication (“wireless service”). For example, the first service plan does not employ telephone while the second service plan employs facsimile.

Furthermore, Appellants submit that unlike the claimed invention, the evaluation of Marsh is not based on the subscriber’s “ability to communicate”. Rather, Marsh’s evaluation is based on “the particular subscriber’s usage patterns across a number of service billing periods” (Marsh, col. 8, lines 61-62). Moreover, “usage patterns” do not teach the subscriber’s “ability to communicate”, but instead teaches a history of actual communication by the subscriber.

Accordingly, Appellants submit that the proposed combination of Dalheimer and Marsh would not have resulted in the claimed invention. The “cost” considered in Dalheimer is not based on a first party’s ability to communicate; rather, the cost considered is not specific to a particular user. Moreover, Marsh does not evaluate the cost effectiveness of a mode of communication of the modes of communication based on the subscriber’s ability to communicate. Instead, Marsh only evaluates whether the subscriber is on an optimal service plan of a single mode of communication (wireless service) based on usage patterns. Therefore, it is Appellants’ position that the prior art of record fails to teach or suggest the claimed features of “evaluating a cost effectiveness of a mode of communication of said modes of communication based on said first party’s ability to communicate” as defined in independent claim 1, 8, and 14. In view the foregoing, the Board is respectfully requested to reconsider and withdraw this rejection.

Further, it is Appellants' position that dependent claims 2-3, 5-7, 10, 12-13, 15-16, and 18-22 are similarly patentable, not only because of their dependency from a patentable independent claims, but also because of the additional features of the invention they defined. In view the forgoing, the Board is respectfully requested to reconsider and withdraw the rejections of claims 1-3, 5-8, 10, 12-16, and 18-22.

Please charge any deficiencies and credit any overpayments to Attorney's Deposit Account Number 50-0510.

Respectfully submitted,

Dated: February 7, 2008

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